

In re Application of LUCOVSKY et al.
Serial No. 10/021,563

REMARKS

The Office action has been carefully considered. The Office action rejected claims 4-5, 7-22, 35-37, 39 and 41 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,480,885 to Olivier et al. ("Olivier") in view of U.S. Patent No. 6,185,551 to Birrell et al. ("Birrell"). Further, the Office action rejected claims 6, 23-34, 38, 40 and 42-43 under 35 U.S.C. § 103(a) as being unpatentable over Olivier in view of Birrell and in further view of U.S. Patent No. 6,643,652 to Helgesen et al. ("Helgesen"). Additionally, the Office action objected to claim 8 for ending with two periods. Applicants have amended claim 8 to obviate the objection raised in the Office action. Regarding the rejections of the claims, applicants respectfully disagree.

By present amendment, claim 4, 8, 19, 21, 35, and 41 have been amended. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on September 8, 2004. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

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The present invention is directed to a system and method for using an inbox service that allows for central (e.g., over the internet) access to specific data typically stored on a server computer. See generally FIG. 4 and pages 16-17 of the specification. The data is typically stored in the form of a content document (for example, content document 422) and the information that designates access to the data is typically stored in the form of a logical inbox document (for example, roleList document 424). These logical documents are part of a schema (for example, service schema 416) for providing the information about the structure of data stored in the system. Such a system is advantageous for storing contact information and the like such that a user may obtain a person's email address or telephone number from any device capable of connecting to the internet. Since the schema provides the information about the structure of data, any device of any platform or communication protocol may access the data.

One embodiment of the present invention features a system and method for providing a schema for coordinating the access, manipulation, and retrieval of data. The schema is a function of the class of service. In this example, the schema is directed to data structures typically used in common email platforms, i.e., an inbox schema. As such, the inbox schema, which is typically in the form of a content document in a markup language, includes inbox-related fields arranged having defined structures.

When another computing device wishes to access or retrieve the data, it will first be determined whether the device has permission to access or retrieve the data. As mentioned above, the inbox service includes a logical inbox document

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that describes a scope of access rights, *i.e.*, which users have what type of access to which data. For example, a data owner will have read/write access to his or her own data, and can provide various types of rights to that data to other users based on their IDs, (*e.g.*, read only to some users, read write to others). Thus, when a user wishes to set the scope as defined in the logical inbox document, the user sends a request to manipulate the data stored in the logical inbox document which controls the scope. In response to the request, at least one set of data in a logical inbox document (data that corresponds to associated identity information) may be manipulated based on the type of request. In this way, each set of data in the logical inbox document corresponds to a related field in the inbox schema and determines the scope of access rights for users according to their identity information.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

Turning to the claims, amended claim 4 recites a method comprising, receiving a request to retrieve inbox data, the request including associated identity information, reading from a data store to obtain inbox data based on the associated identity information, constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data in a markup language, and returning the document in response to the request.

The Office action rejected claim 4 as unpatentable over Olivier in view of Birrell. More specifically, the Office action contends that Olivier teaches constructing an inbox document including at least part of the data, the document

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arranged according to a defined schema for inbox data. Column 5, lines 1-5 and column 16, lines 25-29, of Olivier are referenced. The Office action acknowledges that Olivier does not teach the remaining recitations of claim 4, but contends that Birrell does. More specifically, the Office action contends that Birrell teaches receiving a request to retrieve inbox data, the request including associated identity information, reading from a data store to obtain inbox data based on the associated identity information. Column 5, lines 29-43, column 13, line 41 and column 16, lines 40-43 of Birrell are referenced. Further, the Office action contends that Birrell also teaches returning the document in response to the request. Column 14, lines 48-49 and column 16, lines 3-14 of Birrell are referenced. The Office action then concludes that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the teachings of Olivier with the teachings of Birrell because this would allow a user to interchange useful information, in a number of different presentation modalities, in a timely and convenient manner. Applicants respectfully disagree.

By law, in order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). As discussed in greater detail below, the

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claims of the present invention are thus clearly patentable over the teachings of the cited and applied references as a matter of law.

First, Olivier and Birrell, whether considered alone or in any permissible combination, do not teach or suggest each of the limitations of claim 4. Claim 4 recites constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data in a markup language. A schema, as defined by the Microsoft Computer Dictionary, 5th Edition for example, may be a description of a database to a database management system which defines aspects of the database, such as attributes (also known as fields) and parameters of the attributes. As such, a schema may provide a "roadmap" of how fields are used in the storage of data and the schema itself may be in the form of a content document in a markup language, such as XML.

The Office action contends that Olivier teaches constructing an inbox document arranged according to a defined schema for inbox data. The cited reference to Olivier specifically discloses a database available to an email server wherein the database system includes a schema, data, and a Database Management System, (Column 5, lines 1-5). Further, Olivier discloses delivering reply email messages to an original message via a distribution list of the original message, as opposed to the replying subscriber's distribution list, (Column 16, lines 25-29). Applicants do not understand how the Office action contends that these citations to Olivier teach the recitation of constructing an inbox document arranged according to an inbox schema for the data. Instead, Olivier teaches a well-known email system that uses a database (as most do) having a schema.

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Olivier, however, simply does not teach, much less is even aware of constructing an actual inbox document that is arranged according to the schema. Retrieving information from a schema-based database for a reply email is not the same as constructing an inbox document according to a schema for inbox data in a markup language as recited in claim 4.

Moreover, there is no teaching or even any appreciation of the use of a schema in the manner suggested in claim 4 in the system disclosed by Olivier. Nowhere can there be found in Olivier an inbox schema in the form of a content document such that the schema may be practiced in a common networked environment, such as the internet. Further, nowhere in Birrell can there be found such a document arranged according to a defined schema for inbox data. Neither Olivier nor Birrell, taken alone or in any permissible combination, teach or even suggest a document arranged according to a defined schema for inbox data as generally recited in claim 4.

Claim 4 also recites receiving a request to retrieve inbox data, the request including associated identity information and reading from a data store to obtain inbox data based on the associated identity information. The Office action contends that Birrell teaches these recitations in column 5, lines 29-43, column 13, line 41, and column 16, lines 40-43 of Birrell. Birrell, however, fails to teach or even have any appreciation for a schema-based document access system as generally recited in claim 4. As discussed above, a schema is generally understood in the art to mean a description of a database to a database management system which defines aspects of the database. The account

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manager in Birrell instead is a single database for storing identity-based information and a user may, once validated by checking against the database, access the email server. The cited sections of Birrell teach, generally, a system for providing access to a mail system for remote users. More specifically, an account manager maintains information for users who are allowed to have access to the mail system. Thus, when a user wishes to access the mail system, the user must provide a user name and password that matches the identification stored in the account manager. Simply stated, Birrell teaches securely accessing an email server.

The system and method of the present invention is directed to a completely different concept from simply granting or denying a user access to data. The method recited in claim 4 is directed to determining the manner for which users will eventually be granted or denied permission to access various data stored in the system and the format (based on a schema) of data returned in response to a request. That is, the method of claim 4, generally speaking, provides a schema that among other things determines the setting of the scope of permissions for user access of stored data and the format of data returned in response to a request for data. The Office action fails to appreciate that the method recited in claim 4 is directed to a method for constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data and returning the document in response to the request, and is not directed to a security system for granting or denying access to the data itself.

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Further, by law, in order to modify a reference to reject claimed subject matter, there must be some teaching or suggestion outside of applicants' teachings to do so. Oliver does not have any such teachings or suggestions as to any such modification, let alone any teaching or suggestion as to how his system could be modified, or why it might be desirable to do so. In specific, the motivation for Olivier's system and method is for retrieving information from a schema-based database for replying to email. Nor does Birrell have any teachings or suggestions as to any such modification of Olivier. As discussed above, Birrell is directed to a system for secure access to a mail system by a remote user based on the identity information (*i.e.*, user name and password) of the user. Furthermore, it is simply counter-intuitive to suggest that Birrell teaches the delivery of a constructed document that it does not and cannot construct in the first place. The Office action implicitly acknowledges that Birrell does not teach constructing an inbox document according to a defined schema for inbox data (or else, Olivier would be duplicitous and unnecessary). As such, it does not follow that the Office action now contends it would be obvious to combine the teachings of Olivier and Birrell to arrive at a system that receives a request for a document and delivers the document, but does not construct the document. This premise cannot be supported in that the system of Birrell cannot fulfill a request for a document that it cannot produce, but for importing knowledge from the teachings of Olivier.

This disconnect reveals a complete lack of motivation to combine the teachings of Olivier and Birrell but for the suggestion of the applicants own invention, *i.e.*, hindsight reasoning. As a matter of law, obviousness may not be

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established using hindsight obtained in view of the teachings or suggestions of the applicants. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

To guard against the use of such impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. The mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For at least the reason that neither Olivier nor Birrell, whether considered alone or in any permissible combination, teach or suggest all of the claim limitations recited in claim 4, applicants respectfully submit that claim 4 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 5 and 7-18, by similar analysis, are allowable over Olivier and Birrell, whether considered alone or in any permissible combination. These claims include the recitations of independent claim 4. As discussed above, neither Olivier nor Birrell disclose or suggest the recitations of claim 4, whether considered alone or in any permissible combination. In addition to the recitations of claim 4 noted above, these claims include additional patentable elements.

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For example, claim 8 recites the method of claim 5 wherein the at least one defined field comprises data corresponding to a sender's email address. That is, the field, which is part of the schema for inbox data, may include a sender's email address. In contrast, the cited section of Birrell that the Office action contends teaches this concept actually teaches an HTML-enabled button that is able to reveal the name of the sender in an HTML presented email document. Birrell certainly cannot be construed to teach a defined field with a sender's email address within the context of a schema for inbox data in a markup language. Applicants submit that claim 8 is patentable over the prior art of record at least for this additional reason.

The Office action rejected claim 6 as unpatentable over Olivier in view of Birrell and in further view of Helgeson. Applicants respectfully submit that dependent claim 6, by similar analysis, is allowable over Olivier, Birrell, and Helgeson, whether considered alone or in any permissible combination. Dependent claim 6 includes the recitations of independent claim 4. As discussed above, neither Olivier nor Birrell disclose or suggest the recitations of claim 4, whether considered alone or in any permissible combination. Further, Helgeson certainly does not disclose or suggest any recitations in claim 4. In addition to the recitations of claim 4 noted above, dependent claim 6 includes additional patentable elements.

Turning to the next independent claim, amended claim 19 recites a computer-readable medium having computer-executable instructions for receiving a request to retrieve inbox data, the request including associated identity

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information, reading from a data store to obtain inbox data based on the associated identity information, constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data in a markup language, and returning the inbox document in response to the request.

The Office action rejected claim 19 as unpatentable over Olivier in view of Birrell. More specifically, the Office action rejected claim 19 for identical reasons discussed above with respect to the rejection of claim 1. Applicants respectfully disagree.

There is no teaching or even any appreciation of the use of a schema in the manner suggested in claim 19 in the system disclosed by Olivier. Nowhere can there be found in Olivier an inbox document arranged according to a defined schema for inbox data in a markup language such that the schema may be practiced in a common networked environment, such as the internet. Likewise, nowhere in Birrell can there be found such an inbox document arranged according to a defined schema for inbox data in a markup language. Neither Olivier nor Birrell, whether considered alone or in any permissible combination, teach or even suggest a document arranged according to a defined schema for inbox data as generally recited in claim 19. Applicants submit that claim 19 is allowable over the prior art of record for at least these reasons.

Applicants respectfully submit that dependent claim 20, by similar analysis, is allowable over Olivier and Birrell, whether considered alone or in any permissible combination. Claim 20 includes the recitations of independent claim 19. As discussed above, neither Olivier nor Birrell disclose or suggest the recitations of

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claim 19. In addition to the recitations of claim 19, claim 20 includes additional patentable elements. Applicants submit that claim 20 is allowable over the prior art of record for at least these reasons.

Turning to the next independent claim, amended claim 21 recites a method comprising accessing a network using a device, the accessing including providing associated identity information corresponding to the device, requesting data from a service accessible via the network, the request based on the associated identity information, determining if the request is an allowable request based on the associated identity information, and if the request is allowable, returning a document to the device having at least part of the requested data, the document arranged according to a schema in a markup language associated with the service.

The Office action rejected claim 21 as being unpatentable over Olivier in view of Birrell and, again, the Office action cited identical sections of Olivier and Birrell that were referenced in the rejection of claims 1 and 19 as discussed above. Applicants respectfully disagree.

There is no teaching or even any appreciation of the use of a schema in the manner recited in claim 21 in the system disclosed by Olivier. Nowhere can there be found in Olivier a document arranged according to a defined schema in a markup language associated with a service such that the schema may be practiced in a common networked environment, such as the internet. Further, nowhere in Birrell can there be found such a document arranged according to a defined schema for inbox data. Neither Olivier nor Birrell, whether considered alone or in any permissible combination, teach or even suggest a document arranged

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according to a defined schema associated with a service as generally recited in claim 21. Applicants submit that claim 21 is allowable over the prior art of record for at least these reasons.

Applicants submit that dependent claim 22, by similar analysis, is allowable over Olivier and Birrell, whether considered alone or in any permissible combination. Claim 22 includes the recitations of independent claim 21. As discussed above, neither Olivier nor Birrell, whether considered alone or in any permissible combination, disclose or suggest the recitations of claim 21. In addition to the recitations of claim 21, claim 22 includes additional patentable elements. Applicants submit that claim 22 is allowable over the prior art of record for at least these reasons.

Applicants submit that dependent claims 23-34, by similar analysis, are also allowable over Olivier, Birrell and Helgeson, whether considered alone or in any permissible combination. These claims depend either directly or indirectly from claim 21 and consequently include the recitations of independent claim 21. Neither Olivier, Birrell nor Helgeson, whether considered alone or in any permissible combination, disclose or suggest the recitations of claim 21. In addition to the recitations of claim 21 noted above, these claims include additional patentable elements. Applicants submit that claims 23-34 are allowable over the prior art of record for at least these reasons.

Turning to the next independent claim, amended claim 35 recites a computer-readable medium having computer-executable instructions for requesting data from a service accessible via a network, the request based on associated

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identity information, determining if the request is an allowable request based on the associated identity information, and if the request is allowable, constructing a document in response to the request, the document having at least part of the requested data and arranged according to a schema in a markup language associated with the service.

The Office action rejected claim 35 as being unpatentable over Olivier in view of Birrell and, again, the Office action cited identical sections of Olivier and Birrell as discussed above with respect to the rejections of claim 1 and 19. Applicants respectfully disagree.

There is no teaching or even any appreciation of the use of a schema in the manner recited in claim 35 in the system disclosed by Olivier. Nowhere can there be found in Olivier a document arranged according to a defined schema in a markup language associated with a service such that the schema may be practiced in a common networked environment, such as the internet. Further, nowhere in Birrell can there be found such a document arranged according to a defined schema for inbox data. Neither Olivier nor Birrell, whether considered alone or in any permissible combination, teach or even suggest a document arranged according to a defined schema associated with a service as generally recited in claim 35. Applicants submit that claim 35 is allowable over the prior art of record for at least these reasons.

Applicants submit that dependent claims 36-40, by similar analysis, are also allowable over Olivier, Birrell and Helgeson, whether considered alone or in any permissible combination. These claims depend either directly or indirectly from

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claim 35 and consequently include the recitations of independent claim 35. Neither Olivier, Birrell nor Helgeson, whether considered alone or in any permissible combination, disclose or suggest the recitations of claim 35. In addition to the recitations of claim 35, these claims include additional patentable elements. Applicants submit that claims 36-40 are allowable over the prior art of record for at least these reasons.

Turning to the last independent claim, amended claim 41 recites a method comprising receiving a request to manipulate inbox data in a logical inbox document, the request including associated identity information, determining a scope of access rights based on the identity information, the scope determined according to an inbox schema having inbox-related fields arranged into a content document in a markup language with defined structures for the fields, and if the request is within the scope, manipulating at least one set of data in the logical inbox document that includes data therein according to the associated identity information, each set of data in the logical inbox document structured to correspond to a field in the content document.

There is no teaching or even any appreciation of the use of a schema in the manner recited in claim 41 in the system disclosed by Olivier. Nowhere can there be found in Olivier a document arranged according to a defined schema in a markup language associated with a service such that the schema may be practiced in a common networked environment, such as the internet. Further, nowhere in Birrell can there be found such a document arranged according to a defined schema for inbox data. Neither Olivier nor Birrell, whether considered alone or in

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any permissible combination, teach or even suggest a document arranged according to a defined schema associated with a service as generally recited in claim 41. Applicants submit that claim 41 is allowable over the prior art of record for at least these reasons.

Applicants submit that dependent claims 42-43, by similar analysis, are also allowable over Olivier, Birrell and Helgeson, whether considered alone or in any permissible combination. These claims are dependent directly from claim 41 and consequently include the recitations of independent claim 41. Neither Olivier, Birrell, nor Helgeson, whether considered alone or in any permissible combination, teach or suggest the recitations of claim 41. In addition to the recitations of claim 41 noted above, these claims include additional patentable elements. Applicants submit that claims 42-43 are allowable over the prior art of record for at least these reasons.

For at least these reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

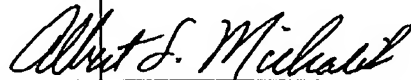
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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 4-43 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



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3080 Second Amendment

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